

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

FJ-2000-044-US

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number

09/784,159

Filed

02/16/01

First Named Inventor

Tanaka

Art Unit

2612

Examiner

Justin P. Misleh

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

(2 pages are filed)

I am the

 applicant/inventor. assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96) attorney or agent of record. 36,769
Registration number _____ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____


Signature

Frederick E. Cooperrider

Typed or printed name

(703) 761-4100

Telephone number

10/31/05

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Hiroshi TANAKA, et al.

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OCT 3 1 2005

Serial No.: 09/784,159

Group Art Unit: 2612

Filed: February 16, 2001

Examiner: Misleh, Justin P.

For: IMAGE INFORMATION OBTAINING METHOD, IMAGE INFORMATION TRANSMITTING APPARATUS AND IMAGE INFORMATION TRANSMITTING SYSTEM

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Box AF

APPELLANTS' ARGUMENTS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Prior to developing a formal Appeal Brief, Appellants submit the following argument for review by more experienced Examiners under the pilot Pre-Appeal Brief Conference.

Appellants hereby request that the Conference attendees refer to the full argument of Appellants on pages 20-23 of the Amendment Under 37 CFR §1.116, filed on September 8, 2005, and do not herein repeat these arguments in their entirety.

In addition to these arguments, Appellants submit that, to one having ordinary skill in the art, the word "canister" in Tomat does not in any way convey a meaning of a directory structure. Indeed, the term clearly conveys a simple memory structure of some sort, not a directory structure.

Second, prior to proceeding to developing the Appeal Brief, Appellants submit that the Examiner has repeatedly failed to provide documentation supporting his position that the word "canister" is used in the art as equivalent to the terminology "directory structure."

Instead, in the Advisory Action dated September 21, 2005, the Examiner attempts to fill in this gap by starting out with the IEEE dictionary definitions of "file directory", "directory", and "directory entry", and proceeding to attempt to rationale that the "canisters"

Serial No. 09/784,159
Docket No. FJ-2000-041 US
Appellants' Additional Arguments for Pre-Appeal Brief Conference

used in the camera of Tomat satisfy one or more of these definitions.

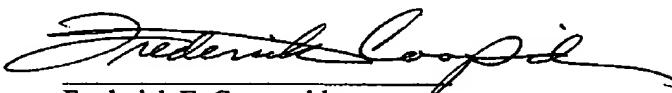
Appellants submit that the problem with the Examiner's approach is that Tomat is also presumed to be at least one having ordinary skill in the art. If Tomat had intended that the term "canister" be equivalent to "directory", then either he should have so stated in that reference or the Examiner has the initial burden of demonstrating that one of ordinary skill in the art has alternative terminology (e.g., "canister") to "directory."

The Examiner has clearly failed to meet this initial burden.

In view of the foregoing arguments, along with those arguments currently of record in the Amendment Under 37 CFR §1.116, filed on September 8, 2005, Applicants submit that the rejection currently of record fails to meet the Examiner's initial burden of a *prima facie* rejection, since the plain meaning of the language of the independent claims is clearly not satisfied, as that language would be interpreted by one having ordinary skill in the art. Accordingly, Appellants respectfully submit that claims 1-45, all the claims presently pending in the application, are clearly patentably distinct over the prior art of record and are in condition for allowance.

Respectfully Submitted,

Date: 10/31/05

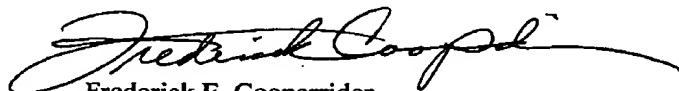


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CERTIFICATION OF TRANSMISSION

I certify that I transmitted via facsimile to (571) 273-8300 the above for the Pre-Appeal Brief Conference to Examiner J. Misleh on October 31, 2005.


Frederick E. Cooperrider
Reg. No. 36,769

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McGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC

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OCT 31 2005

October 31, 2005

VIA FACSIMILE (6 Pages)

To: Examiner: Justin P. Misleh. Facsimile No.: (571) 273-8300
 Group Art Unit: 2612

From: Frederick E. Cooperrider Facsimile No.: (703) 761-2375 or 76

Re: Enclosed Petition and Fee for Extension of Time Under 37 C.F.R. 1.136(a), Notice of Appeal, Pre-Appeal Brief Request for Review Form, and Appellant's Arguments for Pre-Appeal Brief Request for Review
 U.S. Patent Application Serial No. 09/784,159
 Attorney Docket No. FJ-2000-041-US
 Our Reference: MAS.006

Dear Examiner Misleh:

Attached for filing is a Petition and Fee for Extension of Time Under 37 C.F.R. 1.136(a), a Notice of Appeal, a Pre-Appeal Brief Request for Review Form, and Appellant's Arguments for Pre-Appeal Brief Request for Review.

Thank you in advance for your kind consideration on this case.

Very truly yours,


 10/31/05
 Frederick E. Cooperrider
 Registration No. 36,769

FEC:smr
 Attachments

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